



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,639	06/10/2005	Gunter Hoelzemann	MERCK-3020	5419

23599 7590 08/21/2007
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

YOUNG, SHAWQUIA

ART UNIT	PAPER NUMBER
----------	--------------

1626

MAIL DATE	DELIVERY MODE
-----------	---------------

08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,639	Applicant(s) HOELZEMANN ET AL.	
	Examiner Shawquia Young	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-3, 6,7 and 15 are currently pending in the instant application.

I. Response to Amendments and Arguments/Remarks

Applicant's remarks filed August 3, 2007 with respect to the rejection(s) of claim(s) 9 and 10 under 35 U.S.C. § 112, first paragraph for lack of enablement have been fully considered and are persuasive. Therefore, the rejection is rendered moot since applicants have canceled claims 9 and 10. However, upon further consideration, the Examiner has reopened prosecution of this application and a new ground(s) of rejection is made in view of lack of enablement for the subject matter in claim 15 and will be discussed further in detail below.

II. Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first

Art Unit: 1626

paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The nature of the invention

Applicants are claiming a method for the treatment of schizophrenia, or for the control of psychotic anxiety states. See, for example, instant claim 15.

The state of the prior art and the predictability or lack thereof in the art

The state of the prior art is that the treatment of schizophrenia, for example, remains highly unpredictable. Schizophrenia is a mental disorder which is a complex and puzzling disorder. Even the experts in the field are not exactly sure what causes it. Some doctors think that the brain may not be able to process information correctly. There are five recognized types of schizophrenia: catatonic, paranoid, disorganized, undifferentiated and residual. No single characteristic is present in all types of schizophrenia.

Psychosis is a loss of contact with reality, typically including delusions and hallucinations. There are numerous potential causes such as alcohol and certain drugs,

Art Unit: 1626

bipolar disorder, brain tumors, epilepsy, psychotic depression, schizophrenia, etc.

Treatment varies depending on the cause of the psychosis. The expectations for the outcome of the treatment of psychosis vary with the specific disorder and many of the symptoms can be controlled with long-term treatment. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The amount of direction or guidance present and the presence or absence of working examples

There is no evidence of record, which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the numerous diseases or disorders claimed herein. That a single class of compounds can be used to treat all types of schizophrenia and all types of psychotic anxiety states influenced by the binding to the 5-HT receptors. Applicants have not defined in the specification the terms “mental disorders of the schizophrenia type” and “psychotic anxiety states”. Therefore, it is unclear what disorders are truly encompassed by the claimed invention in claim 15. Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating any or all conditions by administering the instant claimed compounds.

The breadth of the claims

The breadth of the claims is a method for the treatment of schizophrenia, or for

Art Unit: 1626

the control of psychotic anxiety states.

The quantity of experimentation needed

The nature of the pharmaceutical arts is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities for each of the diseases and disorders instantly claimed. The quantity of experimentation needed would be undue when faced with the lack of direction and guidance present in the instant specification in regards to testing all diseases and disorders generically embraced in the claim language, and when faced with the unpredictability of the pharmaceutical art. Thus, factors such as "sufficient working examples", "the level of skill in the art" and predictability, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims.

The level of the skill in the art

Even though the level of skill in the pharmaceutical art is very high, based on the unpredictable nature of the invention and state of the prior art and lack of guidance and direction, one skilled in the art could not use the claimed invention without undue experimentation.

To overcome the rejection, Applicants are suggested to cancel the method claim.

III. Conclusion

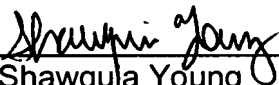
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 6:30 AM-3:00PM.

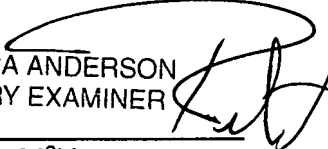

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

Art Unit: 1626

supervisor, Joseph M^{re}Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shawqula Young
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

REBECCA ANDERSON
PRIMARY EXAMINER 
 Joseph M^{re}Kane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600